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DOUGLAS N. LARSON, ESQ.
OPPENHEIMER WOLFF & DONNELLY LLP
2029 Century Park East, Suite 3800
Los Angeles, CA 90067

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/28/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,353

Applicant(s)

MCCARTHY ET AL.

Examiner

Alicia Chevalier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 100-138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 100-138 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12, 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

NEW REJECTIONS

1. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

2. Claims 100-138 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “ultraremovable adhesive” in claim 100 is unclear which renders the claim vague and indefinite. It is unclear how “ultraremovable adhesive” differs from ordinary adhesives on a release liner. For purposes of examination it is considered to be any adhesive that allows a layer to be removed from the adhesive.

Note: The limitation “the infeed end is calendered” is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation “the infeed end is calendered,” since the method of forming the product is not germane to the issue of patentability of the product itself.

Claim Rejections - 35 USC § 102

3. Claims 100-103, 109, 110, 117, 118, 125, 126 and 133 are rejected under 35

U.S.C. 102(b) as being anticipated by Kennedy, Jr. (3,420,364).

Kennedy discloses a sheet comprising a cardstock sheet (reference #5' in figure 5) construction having a front and a back side; a solid continuous liner sheet (reference #1' in figure 5) releasably secured with adhesive (reference #2' in figure 5) to and covering the back side; continuous through-cut lines through the cardstock sheet construction to the back side but not through-cut through the liner sheet; the through-cut lines defining at least in part perimeter edges of printable business cards (oval tags); portions of the back side of the cardstock sheet construction forming back side surfaces of the printable business cards; areas of the liner sheet covering back side of the through-cut lines and thereby holding the printable business cards together; and the liner sheet and the through-cut lines allowing the business cards to be removed from the liner sheet and separated. See column 1, lines 62-67 and figures 4 and 5.

The liner sheet and the through-cut lines allow the business cards to be removed from the liner sheet and separated with the adhesive remaining on the liner sheet and not on back side surfaces of the printed business cards and the leaves the back side surface of the printed business cards tack-free after removal from the liner sheet. See column 2, lines 32-50 and figure 5.

The liner sheet covers all of the back sides of all the facestock through-cut-lines, extends the entire widths of the facestock sheet, and covers the entire back side of the cardstock sheet construction (see figures 2 and 4). At least some of the through-cut lines define a waste border portion of the cardstock sheet construction around the printable business card, include vertical

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and horizontal cut lines, and define all of the perimeter edges of all of the printable business cards (see the figures).

The limitation(s) “of printable business cards” and “when the sheet of printable business cards is fed through a printer or copier for printing operation on the printable business cards” in claim 100 are intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.* In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “through-cut lines are die – cut lines” – claim 126 is a method of production and therefore does not determine the patentability of the product itself.

4. Claims 100, 102-105, 107, 109-113, 117-121, 123, 125 and 126 are rejected under 35 U.S.C. 102(b) as being anticipated by Popat et al. (5,407,718).

Popat discloses a sheet comprising a cardstock sheet (reference #40 in figure 2) construction having a front and a back side; a solid continuous liner sheet (reference #28 in figure 2) releasably secured with adhesive (reference #42 in figure 2) to and covering the back side; continuous through-cut lines through the cardstock sheet construction to the back side but not through-cut through the liner sheet; the through-cut lines defining at least in part perimeter edges of printable business cards (reference #40 in figure 2); portions of the back side of the cardstock sheet construction forming back side surfaces of the printable business cards; areas of the liner sheet covering back side of the through-cut lines and thereby holding the printable business cards together; and the liner sheet and the through-cut lines allowing the business cards to be removed from the liner sheet and separated. See column 2, line 62 to column 3, line 21 and figures 1-3.

The cardstock sheet construction and the liner sheet are both rectangular and have same width and length dimensions (see the figures).

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The liner sheet covers all of the back sides of all the facestock through-cut-lines, extends the entire widths of the facestock sheet, and covers the entire back side of the cardstock sheet construction (see the figures).

At least some of the through-cut lines define a waste border portion of the cardstock sheet construction around the printable business card, include vertical and horizontal cut lines, define all of the perimeter edges of all of the printable business cards, the top one of the horizontal cut lines extends a full width of the cardstock sheet construction, the ends of the rest of the horizontal cut lines are spaced inwardly from the left and right side of the facestock sheet construction, and the rest of the horizontal cut lines extend a distance out beyond the outermost of the vertical cut lines (see the figures).

The printable business cards directly abut one another and share common edges, are arranged in a two column matrix on the cardstock construction, each column of the two column matrix abut adjacent printable media in the same column separated only by respective ones of the through-cut lines, the matrix block cards surrounded by a waste cardstock sheet perimeter, and are arranged in pairs of butt-cut columns and a plurality of butt-cut rows (see the figures).

The cardstock sheet construction includes left and right side edges, the through-cuts lined include frame cut lines and grid cut lines, the frame cut lines include first and second side cut lines spaced in from the left and right side edges respectively, and disposed parallel thereto, and first and second end cut lines spaced in from and parallel to the first and second end edges, both of the end cut lines engaging both of the side cut lines, the frame cut lines defining a central area on the facestock sheet construction, the grid cut lines define disposed central area, and the grid cut lines and frame cut lines separate the central area into the printable media (see the figures).

The limitation(s) “of printable business cards” and “when the sheet of printable business cards is fed through a printer or copier for printing operation on the printable business cards” in claim 100 are intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable

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even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “through-cut lines are die – cut lines” – claim 126 is a method of production and therefore does not determine the patentability of the product itself.

5. Claims 100, 127, 129, 131 are rejected under 35 U.S.C. 102(b) as being anticipated by Casagrande (5,782,497).

Casagrande discloses a sheet comprising a cardstock sheet (reference #3 in figure 1) construction having a front and a back side; a solid continuous liner sheet (reference #15 in figure 1) releasably secured with adhesive (reference #7 in figure 1) to and covering the back side; continuous through-cut lines through the cardstock sheet construction to the back side but not through-cut through the liner sheet; the through-cut lines defining at least in part perimeter edges of printable business cards (reference #17 in figure 1); portions of the back side of the cardstock sheet construction forming back side surfaces of the printable business cards; areas of the liner sheet covering back side of the through-cut lines and thereby holding the printable business cards together; and the liner sheet and the through-cut lines allowing the business cards to be removed from the liner sheet and separated. See the figure and col. 2, lines 26-65.

From figure 1 it can be seen that the liner sheet covers the entire backside of the translucent film layer except for a narrow strip along a leading edge of the facestock sheet.

Claim Rejections - 35 USC § 103

6. Claims 101 and 133 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Kennedy, Jr. (3,420,364).

Popat discloses all the limitations of the instant claimed invention except for the adhesive remaining on the liner sheet and leaving the back side surfaces of the printed business cards tack-free.

Kennedy discloses a sheet comprising a cardstock sheet (reference #5' in figure 5) construction having a front and a back side; a solid continuous liner sheet (reference #1' in figure 5) releasably secured with adhesive (reference #2' in figure 5) to and covering the back side; continuous through-cut lines through the cardstock sheet construction to the back side but not through-cut through the liner sheet; the through-cut lines defining at least in part perimeter edges of printable business cards (oval tags); portions of the back side of the cardstock sheet construction forming back side surfaces of the printable business cards; areas of the liner sheet covering back side of the through-cut lines and thereby holding the printable business cards together; and the liner sheet and the through-cut lines allowing the business cards to be removed from the liner sheet and separated. See column 1, lines 62-67 and figures 4 and 5.

A lacquer coating is placed on the back of the cardstock sheet in order to help facilitate the liner sheet and the through-cut lines to allow the business cards to be removed from the liner sheet and separated with the adhesive remaining on the liner sheet and not on back side surfaces of the printed business cards and the leaves the back side surface of the printed business cards tack-free after removal from the liner sheet. See column 2, lines 32-50 and figure 5.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to add the lacquer layer of Kennedy to the label of Popat in order to obtain a tack-free label. One of ordinary skill would desire a tack-free label so as not to damage fabric or other substrates with adhesive.

7. Claims 106 and 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Carlson (5,842,722).

Popat discloses all the limitations of the instant claimed invention except for card sheet/facestock sheet is coated/glossy.

Carlson discloses a sheet for preparing business forms including die cut cards, which includes an ink receptive coating (abstract and col. 19, line 50 through 3).

It would have been obvious to one of ordinary skill in the art to add an ink receptive coating to the sheet of Popat as taught by Carlson because it would enhance the adhesion of the ink to the card.

8. Claims 108, 114-116 and 124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772).

Popat discloses all the limitations of the instant claimed invention except for the release liner comprising bleach kraft paper and the various thickness of the layers.

Cross discloses label stock comprising a facestock paper, a pressure-sensitive adhesive, a layer of low density polyethylene (film), and denisified bleached kraft paper release layer (figure 5 and col. 5, lines 1-38).

It would have been obvious to one of ordinary skill to use a bleached kraft release liner in Popat as taught by Cross because it has better release properties.

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The exact thickness of the layers is deemed to be a cause effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

9. Claims 134-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Klein (5,198,275).

Popat discloses all the limitations of the instant claimed invention except for the liner sheet including a cut line.

Klein discloses a card stock sheet for making business cards (col. 2, line 47) or a label (col. 3, line 13) comprising a lift out panel (cardstock sheet) with rectangular score cuts (cut lines), an adhesive, and a backing sheet (liner sheet) with perforations (liner sheet cut lines) (figure 6). From figure 3 the laminate member can be seen to have rectangular score cuts (frame cut lines) and score cuts (grid cut lines) and the matrix of cards is surrounded by a waste facestock sheet perimeter.

The exact distance of the liner sheet cut lines to the end of the sheet is deemed to be a cause effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of

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criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add liner cut lines to the sheet of Popat as taught by Klein because it would make peeling the liner off the stock material easier.

10. Claims 137 and 138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Hickenbotham et al. (4,704,317).

Popat discloses all the limitations of the instant claimed invention except for card sheet of paper sheet is calendered.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of Popat as similarly taught by Hickenbotham. One of ordinary skill would be motivated to crush the edge of Popat because crushing the edge of Popat would provide a path of relatively low stiffness and would make the sheet of Popat easier to be dispensed through a printer.

11. Claims 128, 130 and 132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (5,782,497) in view of Hickenbotham et al. (4,704,317).

Casagrande discloses all the limitations of the instant claimed invention except for card sheet of paper sheet is calendered.

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Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

The exact width of the exposed strip is deemed to be a cause effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as width of the exposed strip through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet of Casagrande as similarly taught by Hickenbotham. One of ordinary skill would be motivated to crush the edge of Casagrande because crushing the edge of the combination of Casagrande s would provide a path of relatively low stiffness and would make the sheet of the combination of Casagrande easier to be dispensed through a printer.

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments filed in paper #15 regarding the rejection of record in the previous office action are moot due to the new grounds of rejection.

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Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac
7/24/03

Alexander S. Thomas
ALEXANDER S. THOMAS
PRIMARY EXAMINER